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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,660	08/03/2001	Klaus Heckel	22750/488	8200
26646	7590	10/16/2003	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			SIMONE, CATHERINE A	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,660

Applicant(s)

Heckel et al

Examiner

Catherine Simone

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 3, 4, and 7** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "needle-like" in claims 3 and 4 is deemed vague and indefinite.

Clarification is requested.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester et al. (2,875,543).

Regarding **claims 1 and 2**, Sylvester et al. discloses a floor covering comprising an elastomer material having a relief-type patterned surface, wherein the surface is provided with irregularly distributed indentations (Fig. 9, #17), which have an elongated shape, which partially

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contact or intersect each other. However, Sylvester et al. fails to disclose the indentations having a depth of 0.02 mm to 0.2 mm, at a width of 0.2 mm to 2.5 mm and a length of 5 mm to 50 mm. The optimum ranges of the depth, width and length would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the indentations in Sylvester et al. have a depth of 0.02 mm to 0.2 mm, at a width of 0.2 mm to 2.5 mm and a length of 5 mm to 50 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art absence of showing unexpected results. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Regarding **claims 3, 4 and 17**, Sylvester et al. fails to disclose the indentations being configured so as to run to a needle-like point. Normally, it is to be expected that a change in shape of the indentations would be an unpatentable modification. Under some circumstances, however, changes such as shape may impart patentability to a product if the particular shape claimed produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Dailey et al*, 149 USPQ 47 CCPA 1966.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to change the shape of the indentations in Sylvester et al. be of a needle-like shape. One skilled in the art would have been motivated to do so in order to form a floor covering, since it has been held that the change in form or shape of the indentations would be an unpatentable modification absence of showing unexpected results.

Regarding **claims 11, 12, 20 and 21**, Sylvester et al. fails to disclose the surface percentage of the indentations being 5% to 50% and the floor covering having a thickness of 2mm to 5 mm. The optimum ranges of the surface percentage of the indentations and the thickness of the floor covering would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have in Sylvester et al. the surface percentage of the indentations be 5% to 50% and the thickness of the floor covering be 2 mm to 5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art absence of showing unexpected results. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Regarding **claims 5-7**, each indentation (Fig. 9, #17) intersects at least two other indentations. Regarding **claims 8-10**, each indentation (Fig. 9, #17) have shapes that differ one from the other. Regarding **claim 13**, the indentations have the same depth over their entire length (Fig. 9, #17 and Fig. 2, #3). Regarding **claim 14**, the remaining surface of the floor covering is essentially planar (Fig. 2). Regarding **claims 15 and 16**, the width and length of the individual indentations varies (Fig. 9, #17). Regarding **claim 18**, the floor covering is assembled from individual, repeating surface units (see col.6, lines 27-29). Regarding **claim 19**, the floor covering is made up of a single-layer (see col. 1, lines 34-36).

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*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents are cited for further teachings of floor coverings similar to that instantly disclosed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703)605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone  
Examiner  
Art Unit 1772  
September 30, 2003



HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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10/1/03